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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,171	12/10/1999	LEO J. ROMANCZYK JR.	5677-085	9742

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EXAMINER	
SOLOLA, TAOFIQ A	
ART UNIT	**PAPER NUMBER**
1626	

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/459,171	Romanczyk et al.
Examiner	**Art Unit**
Taofiq A. Solola	1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Feb 25, 2002* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *120-224* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *120-140, 144-179, and 186-244* is/are rejected.

7) ☒ Claim(s) *141-143 and 180-185* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Claims 120-224 are pending in this application.

Claims 1-119 are canceled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 120-140, 144-179, are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapperton et al., "Polyphenols and Cocoa Flavour", presented at the XVIth Internat. Conference of the Groupe Polyphenols, Lisborn, Portugal, vol. 16, 1992.

Applicants claim composition comprising polyphenol (procyanidins) from cocoa. In preferred embodiment the procyanidins is in dimer or oligomer. The composition are in packages having instruction on methods of use. Clapperton et al., disclose composition comprising polyphenol (procyanidins) from cocoa. See the summary, page 1, paragraph 2. The procyanidins are in monomers and oligomers (table 1). The compositions are made into liquor (page 2, paragraph 4, line 2). The difference between the instant invention and that of Clapperton et al. is that applicants claim composition in packages having instruction on methods of use. However, being in packages having instruction on methods of use is not in and of itself patentable over the prior art of Clapperton et al. Having composition in packages with

instruction on methods of use is well known in the art. Therefore, one of ordinary skill in the art would have known to package the composition of Clapperton et al., with instruction on methods of use at the time the invention was made. The motivation is to make additional composition comprising polyphenol (procyanidins).

Claims 186-224, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunder, Phenolic Compounds in Food and Their Effects on Health II, Am. Chem. Soc. Symposium, August 25-30, 1991, pp. 115-120, alone or in view of Chi-Tang Ho, Phenolic Compounds in Food and Their Effects on Health II, Am. Chem. Soc. Symposium, August 25-30, 1991, pp. 2-7.

Applicants claim methods of use monomer and /or oligmer of polyphenol (procyanidins) from cocoa as anti-inflammatory, antihypertensive, antiarteriosclerosis, antioxidant, dietary supplement, etc. Lunder, teaches that green tea contains polyphenol (procyanidins) and their methods of use as anti-inflammatory, antihypertensive, antiarteriosclerosis, antioxidant, etc. The difference between the instant invention and that of Lunder, is that applicants are claiming the methods of use of procyanidins monomers and/or oligomers instead of procyanidins by Lunder. However, Chi-Tang Ho, teaches procyanidins derivatives and their composition from plants including tea. The procyanidins derivatives are monomers and oligomers. See pages 2-3 and table 1, page 7. Chi-Tang Ho further teaches that the derivatives are common in natural and processed food plants, they are antioxidants, inhibit autoxidation of lipids and retard lipid oxidation by inhibition of lipoxygenase activity, etc. Therefore, the instant invention is prima facie obvious from the teachings of Lunder and Chi-Tang Ho. It would have been suggested to

one of ordinary skill in the art to claim the monomers and/or oligomers as anti-inflammatory, antihypertensive, antiarteriosclerosis, antioxidant, etc. at the time the invention was made. The motivation is to make additional compositions useful as anti-inflammatory, antihypertensive, antiarteriosclerosis, antioxidant, etc.

Response to Arguments

Applicant's arguments filed 3/1/02 have been fully considered but they are not persuasive. Applicant argues that the new claims are equivalents of the old claims. Therefore, applicant argues that the new claims are not disclose by Clapperton on the basis that Clapperton does not disclose the composition as in packaged form, comprising carriers with instruction for methods of use. This is not persuasive for reasons set forth above. Applicant may not claim the composition of a compound that is not applicant's invention. If applicant found a new and novel method of using the compound, applicant may claim such methods.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 186-224 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Applications Nos. 09/507,717; 09/717,833; and 09/717,893. Although the conflicting claims are not identical, they are not patentably distinct from each.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 141-143, 180-185, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

This is a RCE of applicant's earlier Application No. 09/459,171. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Taofiq A. Solola whose telephone number is (703) 308-4690. The examiner is on flexible work schedule, and the best days to speak to him are Mondays, Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Taofiq A. Solola, Ph.D.

Primary Examiner

Group 1626

March 20, 2002